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09/669,869	09/21/2000	Thomas Vaughn Wilder	DAREDEV.018RA	4598

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EXAMINER
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FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/669,869

Applicant(s)

WILDER ET AL.

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-13 and 16-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Acknowledgments***

1. The Supplemental Declarations (paper 18 – Supplemental Declaration for Reissue and Supplemental Declaration under 37 CFR 1.131) filed 08-04-2003, the Letter (paper 19) dated 08-04-2003, the Amendment (paper 20) dated 09-04-2003, the Information Disclosure Statement (paper 21) dated 10-14-2003 and the Supplemental Amendment (paper 22) dated 10-14-2003 have been entered.

***Supplemental Oath/Declaration***

2. Note that a Supplemental Oath/Declaration will likely still be required prior to allowance. See Section 1444 of the MPEP.

Note that although a supplemental oath/declaration was filed (paper 18), if any additional amendments are filed, an additional supplemental oath/declaration is still required. See Section 1444 of the MPEP.

***Declaration under 37 CFR 1.131***

3. The rejection under 35 USC 103 rejection of claims 5-8, 10-13 and 16-35 made on the last Office Action (paper 16) as being unpatentable over H-200 Design Drawing (reference 17 of paper 13) in view of Osbourne, US Patent D362,893 (reference 11 of paper 13) and CCM 1997 Roller Hockey Pricelist (reference 15, paper 13) is withdrawn as a result of the showing under 37 CFR 1.131.

Although the four exhibits attached to the Declaration under 1.131 are undated, the Applicant has stated in the 1.131 Declaration that Exhibits 1 and 2 (engineering

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drawings) were made prior to 7-1-1996 (date cited in reference 17 of paper 13).

Exhibits 1 and 2 show the claimed invention of at least independent claims 5, 13, 22 and 29 reduced to practice. All other claims above depend from these independent claims.

### ***Specification***

4. The specification is objected to due to the following:

Page 2 recites "...the holes 32 are preferably 'rockerable', or figure-8 shaped... Rockerable axle holes...".

The term "rockerable" in this recited phrase is objected to due to the following:

Webster's Collegiate Dictionary, 10<sup>th</sup> Edition, defines "rockerable" as: "any of various devices that work with a rocking motion". Note that the holes do not move in a "rocking" motion, or any other motion relative to the chassis.

Also note that while Applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill* 161 F.2d 367 USPQ 482 (CCPA 1947). The term "rockerable" is used by the Applicant to mean "slotted, or, Figure-8 shaped hole in the chassis", while the accepted meaning is "to move in a rocking motion".

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the upper portions

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forming substantially convergent planes in an upwardly extending direction as recited in claim 5 must be shown or the feature canceled from the claim. No new matter should be entered.

Note that the recitation of claim 5 is best understood to be an “alternative embodiment” of the invention of claim 1, where only the forefoot attachment member has upper portions that converge in an upward direction. In contrast, as best understood, claim 5 is claiming that both the forefoot and heel attachment members have upper portions that converge in an upward direction. Note that the concept of an “alternative embodiment” is supported by the first paragraph of page 2 of the specification.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

6. Claims 9, 18, 40 and 52 are objected to because of the following:

A) Claim 9 recites “...said chassis has flush-mounted rockerable axle holes...”.

The term “rockerable” in this recited phrase is objected to due to the following:

Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, defines “rockerable” as: “any of various devices that work with a rocking motion”. Note that the holes do not move in a “rocking” motion.

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Also note that while Applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill* 161 F.2d 367 USPQ 482 (CCPA 1947). The term "rockerable" is used by the Applicant to mean "slotted, or, Figure-8 shaped", while the accepted meaning is "to move in a rocking motion".

B) Claim 18 recites "...wherein each mounting flange extends from its respective upper edge in a direction away from the opposing upper portion".

This recited phrase is objected to due to the following:

1) Claim 18 is dependant upon claim 13.

2) Claim 13 recites "...an upper portion in the forefoot section of each support member...and having an upper edge...and a mounting flange extends from each upper edge...an upper portion in the heel section of each support member... and having an upper edge...and a mounting flange extends from each upper edge..."

3) Claim 13 has only established that the mounting flange "extends" from a "respective" upper edge, and not that the mounting flange "opposes" the upper edge, as recited in claim 18.

C) Claim 40 recites "...wherein the upper portions are curved".

Note that the above recitation of "the upper portions", as best understood, refers to the "upper portions" both in the forefoot and heel region of the roller skate chassis.

While it is noted that the upper portion of the heel region of the skate chassis is curved when viewed from the side, the upper portion of the forefoot region of the skate

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chassis does not appear to be curved when viewed from either the side or end of the skate chassis.

See also claim 52 for a similar recitation.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8, 10-13 and 16-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over H-200 Design Drawing 95078-23 (reference 13 of paper 21), in view of Osborne, US Patent D362,893 (reference 11 of paper 13).

H-200 Design Drawing 95078-23 teaches an integrally formed roller skate chassis comprising:

a heel and forefoot attachment member (top horizontal portion of skate frame);

a pair of longitudinally spaced members (vertical portion of skate frame) having upper edges integrally attached to said heel and forefoot members, said longitudinal members having upper and lower generally planar portions (see "end" view at right side of drawing), said upper portions forming substantially convergent planes in an upwardly extending direction (see "end" view at right side of drawing), said lower portions forming substantially parallel planes (see "end" view at right side of drawing).

H-200 Design Drawing 95078-23 fails to teach one or more web members below the upper portions and above the lower portions.

However, Osborne teaches a similarly structured skate frame comprising one or more web members below the upper portions and above the lower portions (Figures 5-7). Web members between the upper and lower portions on a skate frame are advantageous in that they provide additional strength, lessening the chance of unwanted temporary or permanent deformation of the skate chassis.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize webs in the skate chassis of H-200 Design Drawing 95078-23, as taught by Osborne.

Regarding claim 6, see Figure 7 of Osborne.

Regarding claims 7, 16, 25, 32, 44 and 50, note the recitation of "extrusion profile" on H-200 Design Drawing 95078-23.

Regarding claim 8, note H-200 Design Drawing 95078-23 teaches the material is aluminum.

Regarding claim 10, see Figure 7 of Osborne.

Regarding claim 11, see Figure 6 of Osborne.

Regarding claim 12, the Examiner takes Official Notice that it is common practice to chamfer edges of parts. Chamfering edges provides enhanced visual appearance on edges, such as the web of a skate frame.

Regarding the recitation of "mount holes" in claim 13, see Figure 4 of Osborne.



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Regarding claims 27, 31 and 49, the Examiner takes Official Notice that metal parts are commonly joined by welding. Also note that Section 2144.04 of the MPEP states that it is within the skill level of one of ordinary skill in the art to make integral parts separate. Manufacturing the extruded metal frame, or chassis of H-200 Design Drawing 95078-23 by separate parts which are welded together is advantageous in that the flat portions are easier to manufacture.

Regarding the method of recited in claims 29-35 and 46-52, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the claimed method taught by H-200 Design Drawing 95078-23 (reference 13 of paper 21), as modified by Osborne, US Patent D362,893 (reference 11 of paper 13). Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structure. See MPEP §2112.02. See also *In re King*, 801 F2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

Regarding claims 40 and 52, see the "side view" of H-200 Design Drawing 95078-23.

Regarding claim 47, see the "top view" of H-200 Design Drawing 95078-23.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over H-200 Design Drawing 95078-23 (reference 13 of paper 21) and Osborne, US Patent D362,893 (reference 11 of paper 13), as applied to claim 5, and further in view of Olson, US Patent 5,028,058.

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The combination roller skate chassis of H-200 Design Drawing 95078-23 fails to teach that the skate chassis comprises axle holes that are "rockerable", or are formed as a slot.

However, Olson teaches a skate frame that comprises axle holes (40B or 40C) that are "rockerable" (with, or without use of 82), or are formed as a slot. "Rockerable" axle holes in a skate chassis are advantageous in that the "elongated slot", or "rocking" feature allows the axle to be positioned at more than one location relative to the frame, to suit the preferences of a user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize "rockerable" axle holes in the skate chassis of H-200 Design Drawing 95078-23, as taught by Olson.

Regarding the term "rockerable", see the claim objection portion of this Office Action.

### ***Allowable Subject Matter***

10. Claims 1-4 are allowed.

### ***Reasons for Allowance***

11. The reason's for allowance of independent claim 1 are primarily set forth in the prosecution history of US Patent 5,810,369.

12. The following is a Supplemental Statement of the Examiner's reasons for allowance of independent claim 1:

Claim 1 recites the limitation of a roller skate chassis comprising a pair of laterally spaced first and second longitudinal members, said longitudinal members having generally planar upper portions and lower portions, one of said upper portions of the first longitudinal member being substantially coplanar with a respective lower portion, one of said upper portions of the second longitudinal member being inclined toward the coplanar one of said upper portions in an upwardly extending direction. This limitation, in combination with the other limitations of claim 1, were not found in the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Examiner's Comments***

13. The amendments (papers 20 and 22), including Applicant's comments, have overcome the specification and claim objections set forth in the last Office Action (paper 16).

14. As already noted in this Office Action, the 1.131 Declaration (paper 18) has overcome all 103 rejections set forth in the last Office Action. Note that this 103 rejection was primarily based upon CCM Design Drawing 95078-23 (reference 17 of paper 13). Note that this drawing was undated and the Examiner relied upon a secondary teaching (reference 15 of paper 13) to establish a date (7-1-1996) for the primary teaching (Dwg. 95078-23).

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The 1.131 Declaration "swore behind" Dwg. 95078-23, but did not provide a date that the Instant Invention was reduced to practice, other than to state that it occurred prior to 7-1-1996.

However, the most recently submitted IDS (paper 21) contained a "dated" copy of CCM Design Drawing 95078-23 with the date being 4-16-1996 (reference 13 of paper 21).

Since the Applicant has not set forth any evidence that the Instant Invention was reduced to practice before 4-16-1996, most claims are now rejected under 35 USC 103 in this Office Action (paper 23), as being unpatentable over the "dated" version of Dwg. 95078-23 (reference 13 of paper 21) as being the primary reference.

15. Claim 9 is rejected in this Office Action (paper 23) under 35 USC 103. Since the last Office Action indicated that claim 9 contained allowable subject matter, this action is made non-final.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Specht – teaches a skate frame with slotted axle holes

B) Lo – teaches a skate frame

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17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

 1-2-4  
**BRYAN FISCHMANN**  
**PATENT EXAMINER**